

Appl. No. 09/733,490
Amdt. dated August 30, 2005
Reply to Office action of Nov. 19, 2004

REMARKS

Claims 52-75 are pending and at issue in the present application. Independent claims 52, 58, 64, and 69 have been amended, claims 74 and 75 have been added, and remarks are presented herein. Reconsideration and allowance of all pending claims are respectfully requested.

Before addressing the specifics of the Office action, applicant notes that an amendment to the Specification has been submitted herein. The amendment corrects an obvious error in the description. Consideration and entry of this amendment are respectfully requested.

In the Office action, claims 52-73 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the EZ Pay system in view of U.S. Patent No. 5,056,141 to Dyke, in view of U.S. Patent No. 5,995,630 to Borza, and further in view of U.S. Patent No. 5,764,789 to Pare, Jr. et al. Applicant respectfully traverses this ground of rejection.

There is no motivation to combine the references as suggested by the Office action, and therefore the prior art rejection must be withdrawn. In order to establish a prima facie case of obviousness, there must be actual evidence of a suggestion to modify a prior art reference or to combine two or more prior art references, and the suggestion to combine or modify the prior art must be clear and particular. See, for example, In re Dembiczak, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). The suggestion to combine references must be from the prior art, not Applicant's disclosure. See Section 2143 of the M.P.E.P., which states: "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. Citing In re Vaack, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). In addition, as stated in Section 2142.02 of the M.P.E.P., "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention" (emphasis added. Accordingly, care must be taken to avoid using hindsight to reconstruct the claimed subject matter. In re Oetiker, 977 F.2d 1443, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992). The Examiner must not improperly use the applicant's claim as a "blueprint" to reconstruct the claimed invention from the prior art. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 227 U.S.P.Q. 543 (Fed. Cir. 1985).

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Dyke teaches away from the use of a biometric devices for identifying personnel, and therefore the combination of prior art proposed in the Office action is improper. In stating the rejection, the Office action asserts that:

Dyke teaches a biometric access/restriction solution applicable in [sic] with respect to financial accounts as well as other stored sensitive data (1:10-16)...Evidence to support the combination of EZ [sic] in view of Dyke can be seen as EZ [sic] is concerned with access security as is the entire gaming industry, and Dyke is concerned with general access protection in various field [sic], which include financial accounts. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify EZ's [sic] authentication system to include biometric scanning in the cashier controller as taught by Dyke to increase financial transaction security and prevent unauthorized system access.

Contrary to what is asserted in the Office action, Dyke teaches away from the use of "a biometric access/restriction solution" and therefore one of ordinary skill in the art would not be motivated to modify the EZ Pay system as suggested. While the Office action identifies portions of Dyke that generally describe a biometric input device, the entire reference as a whole must be considered, as required under Section 2142.02 of the M.P.E.P. Accordingly, applicants note that Dyke discredits the use of biometric input devices because they require an "error window" which, if too small, may reject access by authorized users and, if too large, will admit access by unauthorized users (Column 1, lines 31-41). Thus, an object of Dyke's invention, "is to provide an identification system for personnel with a 'zero error' window and no intimate user/device contact" (Column 2, lines 37-39). Biometric input devices require such contact, and therefore Dyke teaches away from the casino gambling system having a biometric input apparatus, as required in the claims.

Instead of a biometric input device, Dyke teaches the use of unique "word-pair" information, where the user memorizes responses to various prompts. Based on the responses to a series of prompts that are stored during enrollment, the system will subsequently identify a user based on responses to a subset of those prompts during an access routine. Dyke, therefore, does not teach or suggest a system that uses unique physical characteristics to identify a user, but instead one that relies on the user's memory, and consequently one of ordinary skill in the art would be motivated by Dyke to modify the EZ Pay system to include a memory-based access system such as the "word-pair" information,

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and not a biometric input apparatus as specified in the claims. Accordingly, the proposed combination of prior art is improper and the rejection based thereon must be withdrawn.

Because Dyke teaches away from the use of a biometric input device, the motivation to combine the Borza reference offered in the Office action is contrary to the reasoning of one of ordinary skill in the art. To justify the addition of Borza, the Office action argues that "One would be motivated to modify EZ [sic] in view of Dyke to include the averaged biometric image data taught by Borza, to increase the likelihood of a positive match and decrease system errors from poor images." As noted above, however, Dyke teaches a system using memorized responses to prompts, rather than biometric images, and therefore the alleged motivation to combine does not exist.

New claims 74 and 75 are also patentable over the cited prior art. Independent claim 74, and claim 75 dependent thereon, specify a casino gambling system having, *inter alia*, a controller operatively coupled to a credit-input device and a biometric input apparatus and programmed to control access to said second computer by verifying the identity of a first person based on a first set of composite digital data, determining whether authorization from a second person is required, and verifying the identity of the second person based on a second set of composite digital data. It is not seen that the cited prior art discloses or suggests such a system.

It is submitted that the present application is in good and proper form for allowance. A favorable action on the part of the Examiner is respectfully solicited.

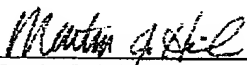
If, in the opinion of the Examiner a telephone conference would expedite prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN LLP

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By:


Martin J. Hirsch
Registration No. 32,237
6300 Sears Tower
233 South Wacker Drive
Chicago, Illinois 60606-6357
(312) 474-6300